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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/579,285	05/30/2000	Nicholas S. Adams	6745	8319

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EXAMINER

ARK, DARREN W

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/579,285

Applicant(s)

ADAMS ET AL.

Examiner

Darren W. Ark

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 8, 9, 12, 20, 25-32, 34 and 38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4, 8, 9, 26-29, 34 and 38 is/are rejected.
- 7) ☒ Claim(s) 1, 12, 20, 25 and 30-32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims 1-4, 8, 9, 12, 20, 25, 30, 31, 32 are objected to because of the following informalities:

Claim 1, line 5, the extra space after "section" should be deleted.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2-4, 8, 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 2, the phrase "said noise generating element...one or more noise generating balls..." renders the claim vague and indefinite since it fails to further modify the term "a fixed number of noise generating objects" set forth in claim 1.

In regard to claim 8, the term "weighted portion" lacks positive antecedent basis.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 26, 27, 29, 34 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Keeton 5,144,765.

Keeton discloses a fishing sinker of unitary ("unitary" defined as "having the character of a unit: WHOLE" as defined in Webster's 1999 New Riverside University Dictionary 1994), one-piece (when the sinker is wholly assembled it represents one single piece) construction comprising with an elongated body (non-floating body member 12) with a line connection end (forward end of the body or also see 60 in Fig. 7), a free end (16 or 66), a weighted section (12 made of metals such as brass or stainless steel or 60 is disclosed as being made of lead) being sufficiently weighted to cause the sinker to sink in water (see Figs. 5-7); and a noise generating element (20 in Fig. 2 or 70 in Fig. 7) non-detachably connected (via 24; see col. 4, lines 3-11 which states that "flaring... so that the collar or ring **cannot be lost**" or 71 on 66 in Fig. 7) by a non-detachable connection (flared end prevents detachment or stop/abutment 71) so that the entirety of the weighted section is between the noise generating element and the line connection end (see Figs. 2, 7), the noise generating member is not removable from the elongated body and comprising a hollow member (32 or 70 [70 may take the form of previous embodiments]) and a fixed number of noise generating objects (34 has a solid wall or has a seam 36 that is joined together using cement or the like after insertion of the objects 34; see Fig. 3a); and the sinker being free of any means for

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varying the size or weight of the sinker (12, 60 do not have means for varying the size thereof).

In reference to claim 29, Keeton discloses the hollow member constructed of a different material (plastic or fiberglass; also see col. 4, lines 58-68 & col. 6, lines 54-58) than the weighted material.

In regard to claim 34, Keeton discloses an eyelet (at end of 18 or 63 in Fig. 7).

In regard to claim 37, Keeton does not disclose the sinker free of any means for varying the size or weight of the sinker (seam 36 sealed by cement or similar thus preventing balls 34 from being altered).

6. Claim 38 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by North 5,946,847.

North discloses a body (jig lure body 35 in Fig. 9; jig fishing is done at depths of water lower than the surface, including the bottom) constructed at least in part of a solid weighted material (metal, see cross-section of Fig. 10); a noise generating element comprising a hollow member (10 embedded in 35); and a fixed number of noise generating objects (two of 5; metal capsule 10 is embedded in body 35); the hollow member (10 made of metal; see col. 7, lines 9-26; elements 5 are constructed of various metals which factor in the construction of metal capsule 10 so as to have a clicking noise of selected intensity and character when coupled with the elements 5) made of a metal different than the weighted section (lead); the weighted material comprises a lead-based material (jig heads are typically made of lead).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keeton 5,144,765 in view of Ravencroft 6,155,000 or Enomoto 5,428,919.

Keeton discloses the collar member being made of colors which blend in with the color of the worm or grub with which the collar is to be used including natural, fluorescent, or neon colors, but does not disclose an exterior dip coating covering the body and noise generating element. Ravencroft discloses a body member (22) where features may be applied thereto by suitable arrangement, i.e., painting, dipping, rubber coating, etc. Enomoto discloses that the sinker main body (2) has a baking finish applied on the outer peripheral surface of the main body so that a coating film formed on the main body is difficult to be peeled off and also provides a beautiful finished external appearance, the coating film having a variety of colors. It would have been obvious to a person of ordinary skill in the art to modify the device of Keeton such that it has features thereon applied thereto using an exterior dip coating in view of Ravencroft or Enomoto in order to make the sinker more attractive to fish using a reliable means for maintaining the desired appearance of the device.

9. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keeton 5,144,765.

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Alternatively, Keeton does not disclose an eyelet at the free end (18) in the embodiment shown in Fig. 2, but it does have an eyelet (63 or to which 98 is attached) at a free end in Figs. 7 or 8. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the embodiment of Fig. 2 such that an eyelet is provided in order to provide a presentation wherein the lure does not slide along the line which may cause some abrasion to the line.

10. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over North 5,946,847.

Alternatively, North discloses a hollow member being made from rigid material (10 made of metal) and that the metal capsule (10) is further defined and adjusted by nature of elements (5) which can be made of metals such as aluminum, copper or steel which factor can be used to construct metal capsule (10) having a clicking noise of selected intensity and character when coupled with elements (5), but does not disclose the hollow member being constructed of a material different from said weighted section. It would have been an obvious matter of design choice to make the hollow member of North such that it is made of a different metal than the weighted section in order to provide a tune the clicking sound of element (5) hitting the walls of hollow member (10) to produce the sound of desired intensity and character since different metals have different densities which translate into different sounds when these different metals impact one another.

11. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over North 5,946,847 in view of Keeton 5,144,765.

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Alternatively, North does not disclose the weighted material comprising a lead based material. Keeton discloses the jig (60, 62) made of a weighted material comprising a lead based material (at col. 7, lines 19-21 Keeton discloses "...for the head 62 of the device 60...FIG. 7 to be quite heavy, such as being made of lead..."). It would have been obvious to a person of ordinary skill in the art to make the device of North out of a lead based material in view of Keeton in order to provide a the necessary weight to fish deep depths and to make the device sink more quickly to the depths desired.

Allowable Subject Matter

12. Claims 1, 12, 20, 25, 30-32 are allowed.
13. Claims 2-4, 8, 9 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bethel '956 discloses the sinker body (12) which may be painted or coated with a resilient or non-resilient coating.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darren W. Ark whose telephone number is (703) 305-3733. The examiner can normally be reached on M-Th, 8:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on (703) 308-2574. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Darren W. Ark
Primary Examiner
Art Unit 3643

DWA